REMARKS

Applicant submits this Amendment and Response to the Office Action mailed on August 28, 2006. In order to ensure consideration of the foregoing amendment and the attached Declaration of Timothy J. Brennan, Applicant is filing concurrently herewith a request for continued examination.

Claim 1 has been amended to incorporate the viscosity limitation of claim 12 in order to reinforce the distinction between the present invention and the prior art. Contrary to the assumptions and generalizations of the Examiner, the cited references do not anticipate nor render obvious the claimed invention. As described in the Declaration of Brennan, the presently-claimed additive was difficult and not obvious to formulate. For any one or more of the following reasons, Applicant submits that the application and claims are in condition for allowance.

At the outset, claim 12 (now claim 1) is rejected as being anticipated by the FR '607 reference. Applicant has found no citation or other discussion in that reference of a viscosity at 40° C of no more than 1.70 mm^2/s. The Examiner has cited no disclosure of viscosity. Accordingly, the anticipation rejection of the present claims in view of the FR '607 reference is traversed.

Claim 12 (now claim 1) is also rejected as being anticipated by the WO '193 reference. The Examiner has cited nowhere in the reference the limitation with respect to viscosity. There is no identification in that reference with respect to viscosity. Accordingly, the anticipation rejection of the present

claims based on the WO '193 reference is traversed.

Claim 12 (now claim 1) is also rejected under 35 U.S.C. §103(a) as being unpatentable over FR '607 in view of WO '362 and SOLVESSO 150. The Examiner nowhere cites in any reference the cloud point of the cited references. Additionally, there is no reference which teaches a viscosity at 40° C of no more than 1.7 mm^2/s. With respect to the cloud point, the Examiner summarily states that the FR '607 and WO '193 references teach the same additive as the present invention; therefore, they would inherently meet the cloud point limitation. This is wrong. With respect to the viscosity limitation, the Examiner has cited the viscosity of a solvent (SOLVESSO 150) only - - not an additive mixture, and at the temperature of 25° C. There is no reference of a formulated additive having any degree of viscosity at any temperature. As described in the attached Declaration of Brennan, the Examiner is not entitled to state that the cloud point of a mixture of any solvent and iron naphthenate is inherent. The Examiner is not entitled to state that a given solvent will result in an additive mixture having the claimed viscosity of at least 1.70 mm^2/s at 40° C.

In order for the Examiner to be justified in making the statement that a given reference inherently discloses the present invention, it must be true that the cited references must have the attribute that is claimed to be inherent. It is not sufficient that a reference may have a particular attribute or even probably has a particular attribute. The Examiner has cited no basis for the

assertions that the cited prior art combination discloses a particular cloud point or a particular viscosity.

As set forth in the Declaration of Brennan, the present invention was developed in order to meet a particular specification of a new engine. According to Mr. Brennan, the challenge was obtaining a low viscosity with solvents that also had to fall within the flash point specification. For instance, most solvents that have a high flash point also have a relatively high viscosity. As described in the present application, because a possible application of the present invention is as an on-board additive, there is also the need for the very low cloud point for the additive. Accordingly, the development of an additive that successfully meets the claimed limitations was a challenge. As noted in the table of the Brennan Declaration, multiple solvents failed with respect to the viscosity limitation. The only other combination of solvents referenced in the table that might have possibly met the viscosity limitation were too low with respect to flash point.

Specifically with respect to "aromatic 150" products, the Aromatic 150 product of ExxonMobil Chemical was inadequate to meet the specifications, because the solvent itself froze at around -5° C. This freezing point was even before the addition of the iron naphthenate which would have made the mixture more viscous. Therefore, by definition, the Aromatic 150 product of ExxonMobil would not meet the cloud point limitation of the present invention.

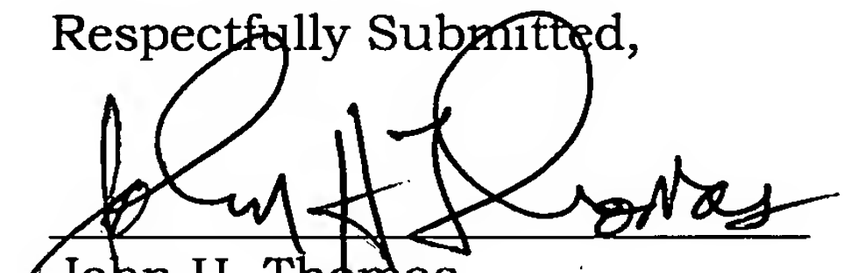
Therefore, it is empirically evident that the conclusory statements of the

Examiner with respect to the cloud point of the SOLVESSO 150 solvent are not supported. All aromatic 150 solvents are not the same. It is not possible nor justified for the Examiner to make the recited rejection on the basis of inherency.

The evidence presented in the Brennan Declaration is conclusive. The prior art cited by the Examiner is not entitled to the breadth of disclosure or arbitrary conclusion with respect to the inherent nature of those solvents. In view of the foregoing amendment, and as described in the Brennan Declaration, the present invention is new and nonobvious over the prior art. All of the rejections are traversed. Favorable action is requested hereon.

The Commissioner is hereby authorized to charge any deficiencies in payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-2127.

Respectfully Submitted,



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the appropriate address at the U.S. Patent and Trademark Office required under 37 C.F.R. ' 1.1(a) on November 13, 2006.

by: _____
John H. Thomas